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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,615	01/18/2002	Thomas Scholl	Mo-6745/LeA	8064

157 7590 05/07/2003

BAYER POLYMERS LLC
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EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,615

Applicant(s)

SCHOLL ET AL.

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7. 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites "pale colored filler" which is deemed to be vague and confusing since the parameter is defined in terms of its physical color, as opposed to its chemical or other constitutional make-up. It cannot be clearly ascertained as to what may be embraced thereby. As such, the scope of the claim is vague. Further, this term has no antecedent basis in claim 17 from which it depends.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Scholl et al ('008) or ('994), both newly cited.

The references to Scholl et al ('008) and ('994) both teach the manufacture of a composition that may comprise at least one solution-polymerized hydroxyl group-containing rubber and containing bonded hydroxyl groups in the range of 0.1 to 5 wt.%. The solution rubbers of the references are produced in an identical method as herein taught. Further, the glass transition temperatures of the examples of the patents lie within the range as herein recited and claimed.

In Scholl et al ('008), note the Abstract and column 2 (lines 13-38) for the basic concept and the monomers employed, including those of claims 8 and 9. Further, note column 4 (line 13) to column 5 (line 62) for the use of additional rubber/elastomer compositions to produce a blend as recited in present claim 11, and the employment of a filler material as recited in claims 13, 14, 17 and 18, including the carbon black and silica mixture as recited in instant claims 18-22. Note Example 1 at column 6 and the table for Example 2 for the glass transition temperatures of the hydroxyl rubber constituent of -11°C and -16°C, respectively. Further, note the first table in column 10 for the amounts of second rubber that may be blended with the hydroxyl rubber constituent, as recited in claim 12. Finally, note the claims.

In Scholl et al ('994), note the Abstract and column 2 (lines 15-29) for the basic concept and the monomers employed, including those of claims 8 and 9, and a recitation of "glass transition temperatures of -50°C to +20°C", well within the range as

herein recited and claimed. Further, note column 4 (line 15) to column 5 (line 62) for the use of additional rubber/elastomer compositions to produce a blend as recited in present claim 11, and the employment of a filler material as recited in claims 13, 14, 17 and 18, including the carbon black and silica mixture as recited in instant claims 18-22. Note Example 1 at column 6 and the table for Example 2 for the glass transition temperatures of the hydroxyl rubber constituent of -11°C and -16°C , respectively. Further, note the first table in column 10 for the amounts of second rubber that may be blended with the hydroxyl rubber constituent, as recited in claim 12. Finally, note the claims.

Claim Rejections - 35 USC § 102/103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Thienot, newly cited.

The reference to Thienot teaches the production of an hydroxyl group-containing diene polymer which may comprise 1,3 butadiene as the diolefin constituent, and having an "average of 1.8 predominately primary...hydroxyl groups per molecule". Note the paragraph bridging column 1 to column 2 for this concept. Note the Abstract. Further, note column 4 (lines 55-58) for the value of "cis-1,4-unsaturation content of about 10-30

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percent". The upper value is deemed to at least render obvious the recitations of claim 10. See the holding to *In re Ayers*, 69 USPQ 109, in this regard, where "at least about 10%" was held to be anticipated by a teaching of a "content not to exceed about 8%".

The reference teaches the manufacture of an hydroxyl group-containing diolefin polymer rubber, as herein recited. The reference is silent with regard to the glass transition temperatures of the final rubber product. However, the compounds of the reference are identical in all chemical aspects, and would presumably be identical in physical aspects, as well, since there is nothing on the record to indicate any differences that would be attributable to the particular Tg values as claimed herein. As such, the claims as herein recited would have been at least obvious, if not anticipated by the teachings of the reference to Thienot.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 703-308-2443. The examiner can normally be reached on Monday-Friday 9:30 am to 6:00 pm.

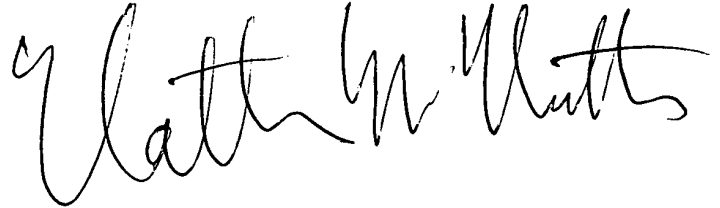
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read "Nathan M. Nutter". The signature is fluid and cursive, with the first name "Nathan" being the most prominent part.

Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn
May 3, 2003